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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,754	05/01/2001	Albert A. Reff	43569.010400	3682

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT PAPER NUMBER

3627

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/845,754

**Applicant(s)**

REFF, ALBERT A.

**Examiner**

Marissa Thein

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-10 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

The Election/Restriction that was sent on December 2, 2005 has been withdrawn because an amendment to the original claims was filed. However, a new Election/Restriction was required on the amended claims. The pending claims that were filed in the amendment are claims 1-5, 7-10, and 17-20.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5 and 7-10, drawn to an apparatus for providing inventory control of medical objects comprising a scanner, a container, a counter, and a reconciling device, classified in class 705, subclass 28.
- II. Claims 17-20, drawn to a method for providing inventory control of medical objected comprising a step of searching the medical objects which are determined to be missing, classified in class 705, subclass 28.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as a step of searching the medical objects which are determined to be missing. See MPEP § 806.05(d).

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Kimbell on February 15, 2006 a provisional election was made without traverse to prosecute the invention of I, claims 1-5 and 7-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-20 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S.**

**Patent No. 4,943,939 to Hoover.**

Hoover discloses the scanner (col. 4, lines 3-6); a container (col. 2, lines 56-61; col. 5, lines 28-52); counter (col. 2, lines 40-44); and a reconciling device (col. 2, line 62 – col.3, line 6; col. 3, line 64 – col. 4, line 6). The Hoover reference is capable of performing the recited functions.

Examiner notes that the clauses “for...” and “adapted for...” are statements of intended use, which do not patentably, distinguish the claimed apparatus.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2-5 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,943,939 to Hoover in view of U.S. Patent No. 5,629,498 to Pollock et al.**

Hoover, substantially discloses the claimed invention, however, it does not disclose a reader **[claim 2]**; an identification device **[claim 3]**; a memory **[claims 4-5]**; an internal counter which is connected the counter **[claims 7-8]**; an alarm mechanism **[claim 9]**; disposable jar and a light emitting diode display **[claim 10]**. Hoover discloses a digital computer for receiving and decoding signals from the dispenser and the storer which decoded signals to enable the computer to count the number of surgical instruments dispensed and received (col. 2, lines 38-44). Hoover further discloses a computer scanning a digital image or dark and light areas created by the instruments (col. 4, lines 3-5).

Pollock, on the other hand, teaches a scanner includes a reader (col. 8, lines 33-39); an identification device (col. 8, lines 31-60); a memory (col. 9, line 42); an internal counter which is connected the counter (col. 6, line 63 – col. 7, line 7; col. 7, lines 64-67;

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col. 9, lines 1-12); an alarm mechanism (col. 3, lines 39-41); disposable jar and a light emitting diode display (col. 3, lines 3-7; col. 10, lines 2-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the apparatus of Hoover, to include a reader, an identification device, a memory, an internal counter, an alarm mechanism, a disposable jar and light emitting diode, as taught by Pollock, in order to decrease the potential for errors in the counting and tracking process (Pollock, col. 2, lines 32-33).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,031,642 to Nosek discloses an integrator-collector which contains a time-correlated digital receiver for maintaining, displaying and recording a count of secured surgical items.

U.S. Patent No. 5,790,409 to Fedor et al. discloses a system for monitoring and dispensing medical items.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mtot  
February 20, 2006



STEVE B. MCALLISTER  
PRIMARY EXAMINER